

**REMARKS**

**Summary of the Official Action**

All the claims in the application, namely, claims 22-27, 31-36 and 41-43, have been rejected under 35 U.S.C. 102(f). The basis of the rejection is that the references relied upon, Zook et al, U.S. 6,525,168, discloses compositions that read on the instant claims 22-27, 31-34 and 41-42, and the Zook et al reference, U.S. 6,723,827, discloses curable compositions that read on the instant claims 35-36 and 43.

The Official Action states that the instant application and the cited references have two common inventors, Jonathan D. Zook and David W. Jordan, and the instant application has four inventive entities, namely, Jonathan D. Zook, David W. Jordan, Susan E. DeMoss, and Chandra B. Rao. The Official Action queried the contributions that each of the inventive entities, particularly Susan E. DeMoss and Chandra B. Rao, made to the instantly claimed invention.

Chandra B. Rao previously submitted a Rule 132 Declaration pointing out the contributions that he as well as his co-inventors, Jonathan D. Zook, David W. Jordan and Susan E. DeMoss, made to the claims of the present invention. The Official Action found this Declaration insufficient because it was not commensurate in scope with the claims. Also, the Official Action goes on to say:

"Further, in the absence of two inventor names, as stated above, the references do disclose the claimed subject matter and there is nothing new between the presence (in the instant application) and absence (the references) of these two inventor names. The Declarations do not disclose the portion in which Susan E. DeMoss and Chandra B. Rao have contributed to the claimed subject matter compared with those of the prior art."

To the extent that Applicants understand the Official Action, they believe the Rao Declaration clearly points out the contributions of each of the inventors to the instant claims. Of

course, each joint inventor does not need to contribute equally to the invention. In addition, the references relied upon are clearly not prior art. To address these points, Applicants are submitting for the Examiner's consideration a second Declaration of Chandra B. Rao, which establishes not only that the present Applicants, Jonathan D. Zook, David W. Jordan, Susan E. DeMoss and Chandra B. Rao, are the correct inventive entity associated with the claims of the instant application, but also establishes that the references relied upon are not prior art.

As noted in the second Rao Declaration, the subject matter of claims 22-27, 31-36 and 41-43 of the present application was disclosed in prior application Serial No. 08/802,130, filed on February 19, 1997. This application is a parent of the present application and is relied upon for the filing date benefit.

The Examiner contends applicants' prior arguments are "not persuasive since they are not commensurate in scope with the claims in that it is based on the steps of the process to form the products and it is not in the claims." Applicants do not understand the Examiner's position. Applicants' claims were amended to narrow the scope to the more particular subject matter disclosed in Application No. 08/802,130, and the Examiner withdrew his prior rejection acknowledging that Applicant was entitled to claim priority from Application No. 08/802,130. See Office Action of October 17, 2005, Interview Summary of January 5, 2005, Reply of January 13, 2006, and Office Action of February 13, 2006.

The second Rao Declaration goes on to point out that at the time Application No. 08/802,130 was filed, he and his co-inventors Zook, Gibson and Jordan, signed a Declaration verifying that they believed that they were the original, first and joint inventors of the inventive subject matter of that application. At the time they signed the Declaration, they were employed by Courtaulds Aerospace, Inc., the assignee of Application No. 08/802,130, and were obligated

and did in fact assign their inventions and patent applications covering the inventions to their employer, Courtaulds Aerospace, Inc, who subsequently became PRC-DeSoto International, Inc. ("PRC"), the assignee of the present application.

Therefore, it is submitted that Jonathan D. Zook, David W. Jordan, Susan E. DeMoss and Chandra B. Rao are the correct inventive entity associated with the claims of the instant application.

The second Rao Declaration goes on to state that he does not understand how U.S. Patent Nos. 6,525,168 and 6,723,827 can be used to reject the claims of the instant application. He points out that he and his co-inventors filed a patent application directed to the subject matter of claims 22-27, 31-36 and 41-43 of the present application at least three years before the alleged inventors designated on U.S. Patent Nos. 6,525,168 and 6,723,827 submitted an application to the U.S. Patent and Trademark Office disclosing such subject matter. Thus, these patents are not prior art to the claims of the instant application.

Moreover, when applicants submit a declaration declaring themselves to be the original, first and joint inventors of the subject matter in issue, "strong evidence is required to reach a contrary conclusion." *Ex parte Kusko*, 215 U.S.P.Q. 972, 973-974 (Bd. Apps. 1981). Zook, Gibson, Jordon and Rao filed such a declaration here about the time of filing Application No. 08/802,130, in February of 1997. A patent application filed three years after applicants' effective filing date does not constitute the strong evidence needed to sustain a rejection based on 35 U.S.C. § 102(f). See *Id.*

In *Kusko*, the evidence found insufficient to sustain rejection based on § 102(f) was a publication dated only about thirteen months after the applicant's effective filing date. As noted in *Kusko*, 215 U.S.P.Q. at 974, an even stronger case is presented when, as here, the evidence

relied upon to sustain a § 102(f) rejection is a subsequently filed patent application, because parties are presumed to have invented common subject matter in the order of their effective filing dates. See, *e.g.*, 37 C.F.R. § 41.207(a).

Based on the remarks set forth above and the second Rao Declaration, it is submitted that Chandra B. Rao and his co-inventors, Jonathan D. Zook, Susan E. DeMoss and David W. Jordan, are the correct inventive entity associated with the claims of the instant application and U.S. Patent Nos. 6,525,168 and 6,723,827 are not prior art to the claims of the instant application. Therefore, the 35 U.S.C. 102(f) rejection should be withdrawn.

Should this amendment raise any questions, and an interference is not declared, the Examiner is urged to contact Applicants' attorney undersigned below for a telephonic interview to resolve the questions. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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